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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,663	03/11/2004	Boyd Willat	29337/PP509A	6308
7590	11/15/2006		EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP BRENT E. MATTHIAS 233 S. WACKER DRIVE SUITE 6300 SEARS TOWER CHICAGO, IL 60606-6357			WILLIAMS, MARK A	
			ART UNIT	PAPER NUMBER
			3676	
			DATE MAILED: 11/15/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/798,663	WILLAT ET AL.	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 28 August 2006.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 54-69 is/are pending in the application.

4a) Of the above claim(s) 64-69 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 54-60, 62 and 63 is/are rejected.

7) Claim(s) 61 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 15 May 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 64-69 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group II, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 8/28/06. The restriction is still considered proper because Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(0)). In the instant case the product can be formed by a different process, such as a molding process.

Therefor, the restriction requirement is FINAL.

2. This application contains claims 64-69 drawn to an invention nonelected with traverse in Paper No. 8/28/06. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 54, 55-59, 62, and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto et al., US Patent 4,911,569. Note especially the embodiments of figures 9-15. A writing instrument comprising an elongate body (2, 46, 1) having first and second ends; a writing mechanism 23 projecting from the body first end; and a deformable sleeve 35 having a generally tubular base 44 with a first diameter and defining an inner surface engaging the body near the writing mechanism, a generally tubular outer membrane 5 with a second diameter larger than the first diameter positioned generally concentric with the base, wherein respective ends of the base and outer membrane engage to define a cavity there between, a sealable passageway 6 defined between adjacent ends of the tubular base and outer membrane in fluid communication with the cavity, and a formable material disposed in the cavity. The base and outer membrane are integrally formed from a single piece of material. The base and outer membrane are generally cylindrical. Opposite ends of the base and outer membrane engage

one another to form flat edge portions on opposite ends of the sleeve. The base inner surface is sized to frictionally engage the body. Regarding claims 56-58, as shown in figure 12, the device appears to be formed as claimed, with a 180 degree fold.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al. in view of David, US Patent 4,617,697. Although the embodiment of figures 9-11 do not explicitly teach the base and outer membrane being bonded together, Hashimoto does further teach the concept of attaching the outer membrane to a similar base-like structure in an alternative embodiment (note figure 19). David provides teaching of a base 18 and outer membrane 16 being bonded together at 14, for the use in a handle environment. It would have been obvious at the time the invention was made for one skilled in the art to have included in the design of Hashimoto such a modification, as generally taught by

David, for the purpose of providing an alternative arrangement that would have functioned equality as well.

***Allowable Subject Matter***

5. Claim 61 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

6. Applicant's arguments with respect to the claims of record have been considered but not persuasive.

Applicant argues that the applied art fails to show a sealable passageway. It is the position of the examiner that such limitations are inherent, since a passageway is clearly shown capable of being sealed. Further, the ends of the member 35 especially at elements 36 can be broadly considered sealed portions. In addition, it is inherent to the design, in light of common knowledge in the art, that once fluid material was placed in passageway 6 that the chamber would have to be sealed to prevent leakage. Even if a syringe were used to fill the passageway, as pointed out by applicant, it would in fact be the case that the elastic closing of the

opening (created by the syringe) once the syringe were removed would be a sealing of the passage as well. No structure has been provided in the claim language distinguishing the sealable passage of applicant's claimed invention from the applied art. The claimed invention is still anticipated by the applied art.

Applicant argues that David can only adapt to the grip of a single user, and that David teaches strong lap joints and does not allow for the claimed sealable passage way arrangement. However, David has been provided only for the teaching of the claimed bonding of the membranes. As outlined in the above rejection, such a bonding is obvious.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will

be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Williams whose telephone number is (571) 272-7064. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark Williams  
11/9/06 



BRIAN E. GLESSNER  
SUPERVISORY PATENT EXAMINER